

**Reply under 37 CFR 1.116 – Expedited Procedure - Technology Center 2145**

**Application No.: 09/875,208**

**Art Unit 2145**

**Docket No.: 3620-P02590US0**

**Examiner: Okudera, et al.**

**REMARKS**

Claims 1-41 are pending in the application, of which all claims stand finally rejected.

**REJECTIONS UNDER 35 U.S.C. 102**

Claims 1-41 stand rejected under 35 U.S.C. 102(e) as being anticipated by Tsuei (U.S. Patent No. 6,654,779). Applicants respectfully disagree with the rejection of at least independent claims 1, 8, and 26, because Tsuei fails to disclose Applicants' claimed feature that the address inquiry system makes the changer (corresponding to recipient in Tsuei) confirm whether the new address of the changer may be disclosed, as variously recited in independent claims 1, 8, and 26.

In Applicants' claimed invention, when the changer permits the disclosure of the new address, then the system informs the inquirer (corresponding to sender in Tsuei) of the new address of the changer. For example, when the address disclosing condition includes a set condition, the address inquiry system makes the changer (corresponding to recipient in Tsuei) confirm whether the new address of the changer may be disclosed. This feature, present in each of independent claims 1, 8, and 26, provides an important advantage to the individual who has changed his/her e-mail address (the changer) which is absent from Tsuei.

In today's world where e-mail users can be inundated with junk e-mail and SPAM, it is not unusual for an individual to change their e-mail address to avoid receiving junk e-mail. The changer of course, after having gone to the trouble of changing their e-mail address and notifying friends and relatives, certainly does not want past senders of junk e-mail/SPAM to be aware of their new e-mail address. The e-mail changer wants to control who will receive their new e-mail address from the database that stores the new address and the old address. Thus, the present invention provides that the e-mail changer controls whether a person sending e-mail to the old address will be given the new e-mail address from the database.

Specifically, claim 1 recites "a data base relationally storing at least the old address, the new address, and an address disclosing condition capable of setting a condition **whereby the changer judges whether to give permission to disclose the new address; ... a means for making the changer confirm whether the new address is disclosed** when the address

**Reply under 37 CFR 1.116 – Expedited Procedure - Technology Center 2145**

**Application No.: 09/875,208**

**Art Unit 2145**

**Docket No.: 3620-P02590US0**

**Examiner: Okudera, et al.**

disclosing condition in searching includes the set condition; and a means for informing the inquirer of the new address when the changer permits the disclosure of the new address...". (Emphasis Added.) Thus, as recited in claim 1, the inquirer (possibly a former sender of junk e-mail) only receives the new address from the database when the changer permits disclosure of the new address. Such a feature is nowhere disclosed within Tsuei.

Similarly, independent claim 8 recites "a disclosure judging means for judging whether to disclose the address to the inquirer based on the address disclosing condition." (Emphasis Added.) Likewise, independent claim 26 recites "disclosure judging step of judging whether the address is disclosed to the inquirer based on a predetermined disclosing condition when the registrant is registered in the address data base..." (Emphasis Added.) Thus, in Applicants' claimed invention as recited in the independent claims, the changer permits or does not permit the disclosure of the new address based on the identity of the inquirer.

In contrast, the Tsuei system in all instances forwards email to the new address without approval or permission of the e-mail changer. For example, Tsuei states that "the sender 110 who finds a new address after making a query of the EAMS 330 can then use the new address to resend the message that caused the bounce message in the first place. The sender 110 may also want to query the EAMS 330 about an address change if the sender suspects, even before sending an e-mail, that the intended recipient 150 has change addresses. In yet another embodiment of the present invention, a sender may be provided with forwarding software that is stored on the sender's computer." (Column 7, line 66-column 8, line 8. Emphasis Added.) In the quoted text of Tsuei, there is no indication that a new mail address of the intended recipient 150 is sent to the sender 110 only when intended recipient 150 (i.e., changer) permits disclosing the new address of the recipient 150. Thus, this quoted text fails to disclose the above-quoted features present in independent claims 1, 8, and 26. In particular, the reliance in the Office Action on the text of Tsuei at column 6, line 66-column 7, line 8 as allegedly disclosing "a means for making the user confirm whether the new address is disclosed..." (Office Action, page 3, fifth paragraph) is misplaced, since in Tsuei the sender "finds" or "is provided with" the new e-mail address, without the changer being able to give permission or to judge whether or not disclose his/her new e-mail address to the sender.

**Reply under 37 CFR 1.116 – Expedited Procedure - Technology Center 2145**

**Application No.: 09/875,208**

**Art Unit 2145**

**Docket No.: 3620-P02590US0**

**Examiner: Okudera, et al.**

Specifically, as further example of how Tsuei fails to disclose the above-quoted claim features (and *even teaches away* from such features), Tsuei states that “[i]n one embodiment of the present invention, the query to the EAMS 330 may include a message that the EAMS 330 *automatically forwards ("autoforwards") [the e-mail] to the new address* if a new address is found. Alternatively, ... if the database 338 correlates a new address with the address sent in the query, *the EAMS 330 informs the entity which sent the query about the new address*. ... In the preferred embodiment of the present invention, the *sender ISP 120 is configured to autoforward e-mail containing an old address to a new address*.” (Column 7, lines 15-33. Emphasis Added.) Thus, in each instance both automatic forwarding of the e-mail to the changer (person who changed their e-mail address) and providing the new e-mail address to a sender (“entity which sent the query”/e-mail) is accomplished in Tsuei automatically, without the chance for the sender to judge whether to permit the automatic forwarding or provision of their new e-mail address to the sender. Such an automatic feature in Tsuei without the ability of the changer to give permission is the antithesis of what is claimed by Applicants in independent claims 1, 8, and 26. Not only does Tsuei fail to disclose the various claim features quoted above, *Tsuei teaches away* from a system and method which permit the e-mail changer to determine whether a not to potential e-mail sender can receive the changer’s new e-mail address.

Hence, for at least these reasons Tsuei fails to disclose each and every element recited in independent claims 1, 8, and 26. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of independent claims 1, 8, and 26, as well as claims 2-7, 8-25, and 27-41, which depend respectively therefrom.

In view of the foregoing amendments and remarks, it is believed that the claims in this application are now in condition for allowance. Early and favorable reconsideration is respectfully requested. The Examiner is invited to telephone the undersigned in the event that a telephone interview will advance prosecution of this application.

**Reply under 37 CFR 1.116 – Expedited Procedure - Technology Center 2145**

**Application No.: 09/875,208**

**Art Unit 2145**

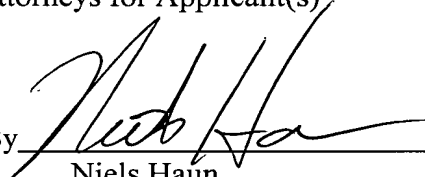
**Docket No.: 3620-P02590US0**

**Examiner: Okudera, et al.**

Respectfully submitted,

DANN, DORFMAN, HERRELL & SKILLMAN  
A Professional Corporation  
Attorneys for Applicant(s)

By



Niels Haun

PTO Registration No. 48,488

Telephone: (215) 563-4100

Facsimile: (215) 563-4044

